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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,290	03/29/2001	Ted N. Magee	271/281	6803

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EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,290

Applicant(s)

MAGEE ET AL.

Examiner

Jerry A. Lorengo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

(1)

Election/Restrictions

Applicant's election without traverse of Group II, claims 43-52 in the reply filed on August 5, 2004 is acknowledged.

(2)

Claim Rejections - 35 USC § 103

The rejection of claims 43-52 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,059,471 to Haigh in view of U.S. Patent No. 4,997,507 to Meyer, as generally set forth in the office action mailed May 11, 2004, stands.

(3)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-46, 48 and 50-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-18 of copending Application No. 10/084,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims 43-46, 48 and 50-52 of the instant invention and that set forth in claims 11-18 of 10/084,262 discloses a method for forming a dye sublimation image comprising the steps of providing a dye carrier having an image which is placed against a surface of a substrate; heating the dye carrier/substrate assembly; cooling the

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dye carrier/substrate assembly; and providing a continuous pressure against the dye carrier/substrate assembly during heating and cooling and there between.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Claims 47 and 49 are likewise rejected due to their dependence upon rejected claim 43.

(4)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43-45, 47 and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,344,103 to Cheng et al.

Regarding applicant claims 43 and 47, Cheng et al. disclose a method for forming a dye sublimation image in a substrate (resin coated watch casing) with a dye carrier 10 having an image 12 formed thereon of sublimatic dyestuff, comprising the steps of:

(1) Placing the image 12 of the dye carrier 10 against the surface A1,A2 of the substrate A to form a substrate/dye carrier assembly (column 2, lines 52-55);

(2) Covering the substrate/dye carrier with an air-tight bag (membrane) 20 (column 2, lines 55-60);

(3) Evacuating air from the interior of the air-tight bag 20 such that a pressure differential is formed across the faces of the air-tight bag thereby clamping the dye carrier 10 against the surfaces of the substrate A (column 2, line 61 to column 3, line 29);

(4) Sealing the air-tight bag 20 to maintain the pressure differential (column 3, lines 29-33);

(5) Heating the air-tight, evacuated bag 20 containing the substrate/dye carrier assembly to a temperature sufficient to bring about sublimation of the image 12 (column 3, lines 33-39);

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(6) Cooling the air-tight, evacuated bag 20 containing the substrate/dye carrier assembly; and upon completion of the cooling process, removing the substrate/dye assembly from the bag 20 and removing the dye carrier from the assembly to form a decorated substrate (column 3, lines 41-43).

Regarding applicant claims 44 and 51, Cheng et al. disclose that the evacuation of air from the air-tight bag provides a pressure over the entire surface of the dye carrier (column 3, lines 23-29).

Regarding applicant claims 45 and 50, Cheng et al. disclose that the bag is evacuated until the pressure approaches 0cm Hg which would result in a pressure of at least 1 atmosphere (14.2 psia) being placed upon the bag, dye carrier and substrate (column 3, lines 23-27).

Regarding applicant claims 49 and 52, Cheng et al. disclose that the heating step occurs at a temperature of between 160 and 180°C (320 to 356°F) for a period of time ranging between 15 to 17 minutes which is sufficient to transfer the ink layer by sublimation from the dye carrier to the surface of the substrate (column 3, lines 33-43).

(5)

Response to Arguments

Applicant's arguments filed August 5, 2004 have been fully considered but they are not persuasive.

The Applicant's main argument is that the combination of the Haigh and Meyer references is unfounded because the Examiner has failed to point out any suggestion in either of the references or the prior art that suggests that without continuous pressure, intimate contact between the dye carrier and the substrate could not be maintained thus resulting in ineffective sublimation and migration of the dye stuff which would cause mars, faint spots and generally unappealing decoration of the substrate. From the above statement, it appears that the Applicant is arguing that the references have been combined utilizing impermissible hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the combination of the Haigh and Meyer references takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made. U.S. Patent No. 6,344,103 to Cheng et al., for example, teaches that if the decal paper carrying the sublimation image is not kept in even and intimate contact with the surface of the substrate, poor transfer will occur (column 1, lines 23-31). The prior art is replete with teachings to this effect.¹ As such, the Examiner respectfully submits that the combination of the Haigh and Meyer references is based upon knowledge which was within the level of ordinary skill at the time the claimed invention was made.

The Applicant also argues that Meyer, even if combinable with Haigh, does not teach the application of continuous pressure during heating and cooling and there between because of his utilization of separate conveyor belts. The Examiner, however, respectfully directs the Applicant's attention to column 8, lines 50-68 where Meyer teaches that the separate conveyor belts may be replaced by a single conveyor belt that extends from the entrance of the feed section through the heating zone and to the exit of the cooling zone. Thus continuous pressure during heating and cooling and there between would be accomplished. Therefore, the Examiner respectfully submits that the rejection of claims 43-52 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,059,471 to Haigh in view of U.S. Patent No. 4,997,507 to Meyer is proper and stands. In addition two new grounds of rejection are set forth in sections (3) and (4), above. As these are new grounds of rejection, this office action is being made non-final.

(6)

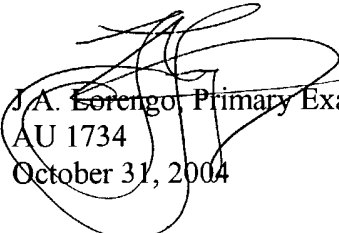
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

¹ See, e.g., U.S. Patent No. 6,136,126 to Fenzi (column 2, line 63 to column 3, line 13); U.S. Patent No. 5,308,426 to Claveau (column 1, lines 10-36); U.S. Patent No. 4,670,084 to Durand (column 1, line 66 to column 2, lines 37); U.S. Patent No. 4,314,814 to Deroode (column 2, line 64 to column 3, line 19).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.A. Lorengo, Primary Examiner

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October 31, 2004